

- 4 (1) means for using a first computer program to analyze the document, without
5 direction from the operator, to identify text in the document that can be used
6 to search for related information,
7
8 (2) means for using a second computer program and the text identified in (1)
9 to search the database and to locate related information, and
10
11 (3) means for inserting the information located in (2) into the document.

REMARKS

This Amendment is in response to the Office Action mailed October 18, 2006.
All objections and rejections are respectfully traversed.

Claims 35-135 are currently pending.

Claims 73, 80 and 87 have been amended to correct typographical errors. Claims 70, 74-77, 84, 91, 97 and 103 have been amended to better claim the invention.

Claims 109-135 have been added to better claim the invention.

At paragraph 9 of the Office Action, the Examiner allowed claims 35-69.

At paragraphs 4 and 5 of the Office Action, the Examiner noted several typographic errors. Applicant thanks that Examiner for pointing out the typographical errors. Appropriate correction has been made via this Amendment.

Applicant thanks the Examiner for the in person interview held on January 18, 2007 with the undersigned attorney and Mr. Atle Hedloy. At the interview, claims 35 and 70 were discussed in light of the Tso reference and specification. By way of this amendment, Applicant believes that the issues raised during the interview have been resolved.

At paragraph 7 of the Office Action, the Examiner rejected claims 70-75, 77-82, 84-89, 91-92, 94-98, 100-104 and 106-108 under 35 U.S.C. §102(b) as being anticipated by Tso (U.S. Patent No. 6,085,201). Applicant respectfully traverses this rejection.

Illustrative claim 70 as amended includes the element of “identifying without user intervention *or designation* the first information.” This is in distinction to the Tso reference where the user must designate text before the analysis of the text. For example in Tso, column 4, lines 32-45, states that a user designates a “text string to be processed, for example, by clicking on it.” Alternately, the designation “could be accomplished by appropriately positioning a cursor using a touch keypad and pressing an ‘ENTER’ key.” Thus, Tso requires that the user designate the first information prior to initiation of the analysis. However, Applicant’s claimed invention identifies the first information without such user designation.

At paragraph 8 of the Office Action, the Examiner rejected claims 76, 83, 90, 93, 99 and 105 under 35 U.S.C. §103(a) as being unpatentable over Tso in view of Pandit (U.S. Patent No. 5,859,636). Applicant respectfully traverses this rejection. Applicant believes that these claims are allowable at least because they depend from allowable base claims.

In a litigation involving U.S. Patent No. 6,323,853, which issued from U.S. Patent Application Serial No. 09/189,626 (a parent of the pending application), the court construed the claims as requiring that “the analysis and search take place without any need for the user to, first, select any text in the document by accenting it, highlighting it, or otherwise selecting it.” The court reached this construction because it concluded that “text selection was clearly disavowed by Arendi during prosecution of the patent.” In support of this conclusion, the court cited the examiner’s rejections based on *Pandit* and

Tso, Arendi's claim amendments and explanations as to how those amendments distinguished these references, and the examiner's statements of his reasons for allowance.

The court's construction was unfortunately overbroad and, we believe, based on too broad a reading of the prosecution history. We wish to avoid such a misinterpretation here. In particular, we distinguish the present invention from *Tso*, as well as *Tso* in view of Pandit, by pointing out that in the present invention, the existence of the "first information", on the basis of which a second information may be retrieved, is marked and/or identified without the user first having to identify the first information. In the words of the claims, the marking (identification) of the first information is done without user intervention, i.e., without the user first having to specify the "first information".

Furthermore, Applicant notes that the phrase "without user intervention or designation" is not a disavowal of *any* user action at all, i.e. not a disavowal of, for example, the need for the user to start the computer, initialize the application program, open or load the document, or perform an action to initiate the identification, such as clicking a button, opening and/or selecting a menu choice, etc. or select among various actions to be thereafter performed once the system or method has marked(identified) the "first information". The key point is that the marking(identification) of "first information" in a document is done by the program or system that implements the method of the invention without the user *first* having to specify the "first information". Thus, to the extent that applicant is disclaiming any "user intervention" in the process, it is disclaiming only the user's spe-

cifically marking(identifying) the “first information” at the outset, not disclaiming any user operations on that information *after* it has been marked(identified).

The Examiner has asked applicant to explain the support in the specification for the term “marking” as used in claim 35 and claims dependent thereon. Applicant has previously identified support for the term “marking” in the Amendment filed on April 15, 2003 in response to the Office Action dated October 15, 2002. In the broadest sense, to “mark” is to pick out or designate something or someone as special in some way. Thus, the verb to mark, as defined by the American Heritage Dictionary (accessed via www.dictionaty.com on February 26, 2007), means, inter alia:

- a. To single out or indicate by or as if by a mark: *marked the spot where the treasure was buried; a career marked for glory.*
- b. To distinguish or characterize: *the exuberance that marks her writings; marked the occasion with celebrations.*
- c. To make conspicuous: *a concert marking the composer's 60th birthday.*
- d. To give attention to; notice: *Mark her expression of discontent. Mark my words: they are asking for trouble.*
- e. To take note of in writing; write down: *marked the appointment on my calendar.*

In the present case, the program marks the “first information” in any of a variety of ways. Thus, it automatically (i.e., without user intervention) identifies (i.e., singles out) certain text found in a document (e.g., a name) that may serve as the “first information” for searching in a database to find corresponding (“second”) information. See p. 2, paragraph 35 of the application:

The program analyzes what the user has typed in the document at step 4, for example, by analyzing (i) paragraph/line separations/formatting, etc.; (ii) street, avenue, drive, lane, boulevard, city, state, zip code, country designators and abbreviations, etc.; (iii) Mr., Mrs., Sir, Madam, Jr., Sr. designators and abbreviations, etc.; (iv) Inc., Ltd., P.C., L.L.C, designators and abbreviations, etc.; and (v) a database of common male/female names, etc.

Further, it may display the text (the “first information”) to the user: see, for instance, Example 4, page 4, paragraph 53 in which the system, in response to having identified the name and address of a contact in a document, searches a database and displays any already-existing name and address for the contact:

The user commands the button 42, for example, marked “OneButton,” and the program according to the present invention retrieves the existing contact 44 from the document, searches a database for the same name of the existing contact 44 and generates a screen as shown in, for example, Fig. 9. This screen includes a message 70 informing the user that the contact already exists in the database with an existing address, a message 72 including the existing address, add new contact with same name selection 74, change existing address selection 76, use existing address in document selection 78, add the new address contact selection 80, the address type selection 54, such as home, business, etc., and the “OK,” “Details,” and “Cancel” buttons 56, 58 and 60 respectively.

The user may then use the retrieved data or add to it or take other action. See also figures 6, 9, 10, 11 and 12, and examples 2, 5, 6 (paragraphs 45-48, 55-58, and 59-62 respectively).

Furthermore, in paragraph 35 of the published application, “At step 6, the program decides what was found in the document and if the program found nothing in the document or what it found was un-interpretable the program goes to step 8 and outputs an

appropriate message to the user and then quits at step 16.” Thus, also if no first information is found, the claimed invention alerts the user.

Applicant believes that all claims are in condition for allowance and respectfully requests the issuance of a Notice of Allowance.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

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